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Patent
Attorney Docket No. GEMS8081.108

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Trevino et al.
Serial No. : 09/683,129
Filed : November 21, 2001
For : **METHOD AND APPARATUS FOR MANAGING
WORKFLOW IN PRESCRIBING AND
PROCESSING MEDICAL IMAGES**
Group Art No. : 2672
Examiner : Lee, H.

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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**PETITION UNDER 37 C.F.R. §1.144 SEEKING
SUPERVISORY REVIEW OF RESTRICTION REQUIREMENT**

Dear Sir:

Responsive to the Restriction Requirement made Final June 14, 2004, Applicant requests consideration of the following remarks in support of the rejoinder of claims 1-32.

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REMARKS

In the Office Action mailed March 5, 2004, the Examiner imposed a two-way restriction of claims 1-32. The Examiner identified Group I, claims 16-32, as "drawn to a magnetic resonance imaging (MRI) apparatus for acquiring medical imaging data" in class 378, subclass 162, and identified Group II, claims 1-15, as "drawn to specific functions of a Graphical User Interface (GUI) for prescribing medical imaging session" in class 345, subclass 810. In response, Applicant timely filed an election with traverse and remarks supportive thereof. In the most recent Office Action, mailed June 14, 2004, the Examiner withdrew non-elected claims 16-32 from consideration. Applicant believes that the Examiner's restriction of claims 1-32 is incomplete and improper and therefore requests review of the Examiner's holding.

In the original Restriction, the Examiner indicated that the identified groups are "distinct" and related as combination (Group I) and subcombination (Group II). The Examiner reasoned that:

Proper functioning of the magnet, wherein a magnetic field is created in order to obtain MR images, does not require the specific functions of GUI as disclosed for invention II. The GUI allows user input during the medical imaging process, but the user input is not required. The MRI apparatus is able to obtain MR images in automatic mode based on pre-programmed automation process without the need for user input using the GUI. (Office Action mailed 5/4/04, emphasis added).

The Examiner also asserted that the subcombination has separate utility as a GUI for several modalities of medical imaging other than MRI.

According to MPEP §806.05(c), "inventions are distinct if it can be shown that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability." (Emphasis added). Thus, whether a subcombination is required for "proper functioning" of the combination is wholly irrelevant to restriction analysis. The patentability of a combination is independent of the combination's ability to perform a particular function without the subcombination. The Examiner's stated rationale, true or not, has no bearing on whether restriction is proper between Groups I and II. Section 806.05(c) further states that "[i]f there is no evidence that combination ABsp is patentable without the details of Bsp, restriction should not be required."

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(Emphasis added). Stated otherwise, to prove that the combination and subcombination are distinct, the Examiner must provide evidence of novelty found solely in the combination. As noted in the Election Response filed April 1, 2004, "Applicant does not contend that an MRI apparatus and a method for acquiring medical images are patentable without the details of the subcombination." Therefore, since the Examiner has not provided any evidence showing the combination to be patentable without the subcombination, and since Applicant has not asserted patentability of the combination without the subcombination, restriction is not proper.

The Examiner further contended that "the subcombination has separate utility such as the GUI of invention II is applicable to a plurality of medical imaging apparatus, such as CT, X-ray, and ultrasound imaging." However, separate utility of the subcombination is irrelevant when the combination and subcombination are not distinct. In the Election, Applicant referred the Examiner to MPEP §806.05(c), which states that "[w]here the relationship between the claims is such that the separately claimed subcombination Bsp constitutes the essential distinguishing feature of the combination ABsp as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility." (Emphasis added). Since it has not been shown that the combination is patentable without the subcombination, the inventions are not distinct and separate utility of the subcombination is therefore immaterial.

Applicant has also shown that elements expressly called for in the claims illustrate these points. As noted above, the Examiner has identified Group I as drawn to an MRI apparatus, and Group II as drawn to a GUI for prescribing medical imaging sessions. However, in the Election Response Applicant noted that claims 16, 18, 20, 21, 22, 23, 24, 25, 26, 27, 29, 30, and 32 of Group I call for a "GUI" and describe attributes thereof. An examination of all the claims of each group, rather than merely the independent claims, shows that the two groupings contain similar elements and are interrelated. Thus, it cannot be said that the combination as claimed does not require the subcombination since a significant portion of the claims of the combination call for and are expressly directed to a medical imaging GUI and its functionality.

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In the most recent Office Action, the Examiner stated that "the details of the GUI as disclosed in Group II are not incorporated" into Group I. However, most of the particular details mentioned by the Examiner actually are called for in the claims of Group I. The Examiner first asserted that "a plurality of modularizing selectors," does not exist in Group I. However, claim 25 of Group I plainly calls for "a number of ... modularizing tabs." The Examiner also contended that "a plurality of modularizing selectors aligned vertically" is not found in Group I. However, claim 29 of Group I states that "the number of modularizing tabs are arranged vertically." The Examiner then noted "status indicators" as missing from Group I. However, claim 32 of Group I expressly calls for "a number of status indicators."

Also, the "messaging module" noted by the Examiner can be found in claims 30 and 31 of Group I. The function of the messaging module of claim 1 is to "display messages regarding the imaging application." Claim 30 calls for the step of "displaying messages to an operator in a bottom region of the GUI," and claim 31 lists several examples of what the messages might contain. Therefore, claims 30 and 31 call for a "messaging module" in even more detail than found in Group II. Finally, claims 20, 30, and 31 of Group I call for, in part, "a plurality of windows corresponding in number to the plurality of modularizing selectors, the plurality of windows configured to present a number of scan parameters" and "a messaging module includ[ing] a pop-up dialog configured to display an invalidity of a user input," as called for in Group II.

Furthermore, Applicant also believes that the Examiner's procedural basis for restriction is improper since (1) no distinctiveness has been shown between the groups, and (2) the Examiner has not stated a reason for insisting on restriction. MPEP §808 states that "[c]very requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween as set forth in the following sections." As shown above, the groupings are not distinct. In addition, assuming the inventions are independent or distinct, the Examiner has not thus far provided any reasons for insisting on restriction as required by MPEP §808.02. Such reasons must be set forth by the Examiner, and in their absence, the present restriction is improper.

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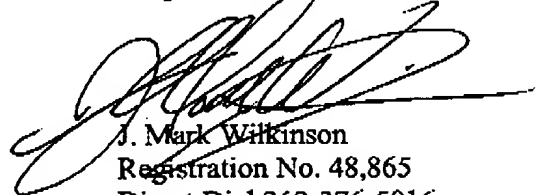
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In sum, since the Examiner has not shown that the combination claims are patentable without the elements of the subcombination claims, the inventions are not distinct. Since the inventions are not distinct, separate utility of the subcombination is immaterial. In addition, an examination of all the claims of the restricted groups evidences that the inventions are interrelated and that the combination as claimed clearly requires the subcombination. Therefore, the rejection is procedurally incomplete and cannot be sustained. For at least these reasons, Applicant respectfully requests rejoinder of all claims.

A Fee Transmittal form is enclosed.

Applicant appreciates the consideration of these Remarks and cordially invites a call to the undersigned, should any matters be deemed unresolved.

Respectfully submitted,



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Dated: _____
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